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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,260	06/02/2006	Yves Auberson	33443-US-PCT	2480
75074 7590 09/30/2008 NOVARTIS INSTITUTES FOR BIOMEDICAL RESEARCH, INC. 400 TECHNOLOGY SQUARE CAMBRIDGE, MA 02139				
EXAMINER JARRELL, NOBLE E				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
09/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,260

Applicant(s)

AUBERSON ET AL.

Examiner

NOBLE JARRELL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 4/26/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of group IV in the reply filed on 8/25/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

2. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. GB 0325830, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. There is no support for variable U being a bond. Thus, the priority date for the elected group of the instant application is November 4, 2004.

Claim Objections

3. Claims 1-9 are objected to because of the following informalities: these claims contain non-elected subject matter. Appropriate correction is required.

Information Disclosure Statement

4. The information disclosure statement filed 4/26/06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information

or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. No copies of the cited documents in the IDS have been submitted.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-9 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Formula I of claim 1 has no core structure. For example, variable U can be a bond, a haloalkyl group, a cyclopropyl group, or an aryl or heteroaryl group. Variable X is selected from alkanylylidene, alkylene, cycloalkylene, piperidinyl, and a number of other rings. Variable Y can be O, S(O)₂, S(O)₂NR₉ or the opposite, NR₉, C(R₉)OH, C(O)NR₉ or the opposite, or C(O)N(R₉)O or the opposite. In addition, variable n is an integer from zero to five. Taken together, formula I has no one core structure.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The issue concerning the meaning of "second drug substance" in claim 9 is discussed in the 35 U.S.C. 112, paragraph 2 rejection. Claim 9 does not contain generic formulae indicating

structural makeup for the "second drug substance" for combination drug therapy. Nor is there any description of the substance intended in the specification.

According to the MPEP §2163 I. A. "the issue of a lack of adequate written description may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art." The MPEP states in §2163 II 3 ii) "The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice (see i)(A), above), reduction to drawings (see i)(B), above), or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus (see i)(C), above). See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406."

According to the MPEP §2163.02 Standard for Determining Compliance With the Written Description Requirement, "The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed". In re Gostell, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those

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skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter". *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983))."

This case was filed before Applicants had a clear idea of the structures encompassing the scope of claims 1-2 and 19-22, other than the specific compounds recited in claims 11 and 12. The specification provides broad areas of future research and speculation, inviting undue experimentation in learning how to use Applicants' invention.

Applicants are reminded of what the U.S. Court of Appeals Federal Circuit wrote in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398, "In claims involving chemical materials, generic formulae usually indicate with specificity what the generic claims encompass. One skilled in the art can distinguish such a formula from others and can identify many of the species that the claims encompass. Accordingly, such a formula is normally an adequate description of the claimed genus." "A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the gene does, rather than what it is. See *Fiers*, 984 F.2d at 1169-71, 25 USPQ2d at 1605-06 (discussing *Amgen*). "It is only a definition of a useful result rather than a definition of what achieves that result." "The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d

1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.")".

7. Claims 8-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for *in vitro* inhibition of BACE and amyloid peptide 1-40, does not reasonably provide enablement for *in vivo* use of these compounds as treatment for a vascular or neurodegenerative disorder related to β -amyloid generation and/or aggregation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Applicants show that they inhibit BACE and amyloid peptide 1-40 *in vitro* with tests 1,2, and 4 (pages 10 and 11 of the specification).

The factors to be considered in determining whether a disclosure meets the enablement requirements of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir., 1988). The court in *Wands* states, "Enablement is not precluded by the necessity for some experimentation, such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue', not 'experimentation'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations" (*Wands*, 8 USPQ2d 1404). Among these factors are: (1) the nature of the invention; (2) the breadth of the claims; (3) the state of the prior art; (4) the predictability or unpredictability of the art; (5) the relative skill of those in the art; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

Consideration of the relevant factors sufficient to establish a *prima facie* case for lack of enablement is set forth herein below:

(1) *The nature of the invention and (2) the breadth of the claims:*

The claims are drawn to a method of inhibiting β -amyloid generation and/or aggregation using compound with a macrocyclic lactam where the only required functional group is an amide group. Compositions containing these compounds

are also claimed. Thus, the claims taken together with the specification imply that these compounds can inhibit β -amyloid generation and/or aggregation.

(3) The state of the prior art and (4) the predictability or unpredictability of the art:

Hardy et al. (*Neuron*, **2006**, 52, 3-13) teach that several problems exist with BACE inhibition (large active site, mice do not show pathological defects, and difficulty crossing the blood brain barrier) (page 6, "section titled "APP Processing and Deposition as a therapeutic target in Alzheimer's disease"). As to amyloid peptides, it is still unknown whether amyloid β is linked to Alzheimer's ("Concluding Remarks", pages 7-8).

(5) The relative skill of those in the art:

Those of relative skill in the art are those with level of skill of the authors of the references cited to support the examiner's position. The relative skill of those in this art is MD's, PhD's, or those with advanced degrees and the requisite experience in inhibition of β -amyloid generation and/or aggregation.

(6) The amount of direction or guidance presented and (7) the presence or absence of working examples:

The specification has provided guidance for *in vitro* inhibition of BACE and amyloid peptide 1-40.

However, the specification does not provide treatment of vascular or neurological disorders related to β -amyloid generation and/or aggregation.

(8) The quantity of experimentation necessary:

Considering the state of the art as discussed by the references above, particularly with regards to claims 8-9 and the high unpredictability in the art as evidenced therein, and the lack

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of guidance provided in the specification, one of ordinary skill in the art would be burdened with undue experimentation to practice the invention commensurate in the scope of the claims.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what disorders related to β -amyloid generation and/or aggregation are being treated. What is the "second drug substance" being used in combinatorial therapy? No guidance is given as to what the substance is.

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 6-7 provide for the use of compounds of formula I, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 6-7 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Double Patenting

12. Claim 4 is objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1 and 3. When two claims in an application are duplicates or else are so close in content that

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they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The intended use of a compound of formula I does not carry any patentable weight in a compound claim.

Conclusion

13. The elected group appears free of the prior art of record.
14. Ripka et al. (*Bioorganic and Medicinal Chemistry Letters*, **1998**, 8, 357-60) teach compounds 6 and 7 (page 358). These compounds do not anticipate or render obvious compounds of the elected group because $\text{CH}_2\text{-R}_1$ cannot be a methyl group. It has to be $\text{CH}_2\text{-CH(R}_e\text{)C(O)N(R}_a\text{)(R}_b\text{)}$ or $\text{CH}_2\text{-(CH}_2\text{)}_k\text{N(R}_c\text{)R}_d$ group.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **NOBLE JARRELL** whose telephone number is (571)272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Noble Jarrell/
Examiner, Art Unit 1624

/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624